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Paper No.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **S2 Yachts Inc.**

Serial No. 75/**387,625**

H. W. Reick of **Price, Heneveld, Cooper, DeWitt & Litton** for **S2 Yachts Inc.**

James A. Rauen, Trademark Examining Attorney, Law Office 103
(**Michael A. Szoke**, Managing Attorney).

Before **Quinn, Hohein** and **Rogers**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

S2 Yachts Inc. has filed an application to register
the mark "TIARA" for the following goods:¹

¹ Ser. No. 75/387,625, filed on November 10, 1997, which sets forth dates of first use of September 1977 for the goods in each class. In the application, applicant claims ownership of Reg. No. 1,076,367, issued on November 1, 1977, for the mark "TIARA" for "powerboats (specifically not to the engines per se for such boats)." Such registration, which has been renewed, sets forth a date of first use anywhere of September 7, 1976 and a date of first use in commerce of September 25, 1976.

"tools, namely, utility knives and multi-purpose pliers" in International Class 8;

"pens" in International Class 16;

"expandable gear bags and boat duffel bags" in International Class 18;

"key chains, namely, floatable key chains" in International Class 20;

"insulated plastic glasses, coffee mugs, [and] metal and leather coasters" in International Class 21; and

"jackets, sweatshirts, parkas and baseball caps" in International Class 25.

While the Examining Attorney notes that the application is in condition for publication of the mark as to the goods in International Classes 8 and 16,² registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the grounds that: (i) when applied to the goods in International Class 18, applicant's mark so resembles the mark "TIARA," which is registered for "luggage,"³ as to be likely to cause confusion, mistake or deception; (ii) when applied to the goods in International Class 21, applicant's mark so resembles the marks "TIARA" and, as reproduced below, "A TIARA EXCLUSIVE" and design,

² However, as the Examining Attorney further notes, applicant "has chosen not to divide the application."

³ Reg. No. 1,477,701, issued to American Tourister, Inc. on February 23, 1988, which sets forth dates of first use of January 1987; combined affidavit §§8 and 15.

which are both registered by the same registrant for the following goods,⁴

"glass gift and tableware, namely, wine sets consisting of serving tray, wine glasses, and decanter; pitchers, serving platters, handle baskets, console bowls, goblets, covered candy boxes, covered butter dishes, party serving plates, dinner ware place settings, sugar and cream sets, bon bon dishes, compotes, double serving dish, water tumblers, salad servers, chip and dip salad bowls, salt and pepper sets, punch sets consisting of punch bowls and cups, beverage sets consisting of pitcher and tumblers, decanters, water bottles, juice servers, demijohns, honey dishes, and candy dishes";

as to be likely to cause confusion, mistake or deception; and
(iii) when applied to the goods in International Class 25,

⁴ Respectively, Reg. No. 1,417,482, issued to Indiana Glass Company on November 18, 1986, which sets forth dates of first use of July 1, 1970; combined affidavit §§8 and 15; and Reg. No. 1,142,609, issued to the same firm on December 9, 1980 with a disclaimer of "EXCLUSIVE," which also lists "chalices" and "cookie jars" and sets forth dates of first use of July 1, 1970; combined affidavit §§8 and 15.

applicant's mark so resembles the mark "TIARA INTERNATIONAL," which is registered for "clothing, namely[,] T-shirts, [and] sweaters,"⁵ as to be likely to cause confusion, mistake or deception. Registration has also been refused under Section 1(a)(2) of the Trademark Act, 15 U.S.C. §1051(a)(2), on the grounds that, with respect to the goods in International Class 18, the item "expandable gear bags" is indefinite and that, with respect to the goods in International Class 20, the identification thereof is indefinite.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register under Section 2(d) and, as to the refusals to register under Section 1(a)(2), the refusal with respect to International Class 18 is reversed and that with respect to International Class 20 is considered to be moot.

Turning to first to the latter refusals, applicant argues with respect to the item of "expandable gear bags" in International Class 18 that such goods "are the type of soft cover bags which are uniquely appropriate for use on boats where storage can be at a minimum and flexible and expandable bags provide the boat owner with the ability to stuff, prod

⁵ Reg. No. 1,987,368, issued to Tiara International, Inc. on July 16, 1996 with a disclaimer of "INTERNATIONAL," which sets forth a date of first use anywhere of November 1991 and a date of first use in commerce of July 1992.

and push the bag and its contents into small irregularly shaped storage areas frequently found on a vessel." According to applicant:

The term "gear" is widely known by sailors and boat owners alike as defining any manner of items which they carry aboard, typically for a day sail or cruise, and may include items such as clothing, food, or anything typically taken aboard a vessel for consumption or subsequent removal. The term "gear" is an accepted, well-known term and does not render expandable gear bags indefinite in the nautical context in which the goods are intended to be described.

The Examining Attorney, on the other hand, maintains that the terminology "expandable gear bags" is "unacceptable as indefinite." Asserting that the identification of goods must specify the type of "gear" for which the bags are intended, the Examining Attorney contends that "this information is required because it will determine the classification of the goods." By way of examples, the Examining Attorney notes that "bags for hunting 'gear' are classified in International Class 13, bags for fishing 'gear' are classified in International Class 28, bags for travel 'gear' are classified in International Class 18, etc."

We agree with applicant, however, that the item "expandable gear bags" is sufficiently definite to permit proper classification in International Class 18. As confirmed by the specimens of use, such bags are essentially in the

nature of an expandable duffel bag, an all-purpose athletic, beach or sport bag, or a carry-on gym or travel bag, all of which are properly classified, according to the Trademark Acceptable Identification of Goods and Services Manual of the United States Patent and Trademark Office, in International Class 18 irrespective of the fact that, as so identified, they could be used to hold a variety of contents classified in other classes. Plainly, when viewed in the context of "expandable gear bags and boat duffel bags," the item "expandable gear bags" denotes a specific type of general purpose luggage just as does the term "boat duffel bags." Consequently, we see no valid reason why applicant should be required to particularize its expandable gear bags further by the type of gear which might temporarily be stored and/or carried therein. As applicant points out in its reply:

It is impossible to imagine or list all items a boater may place in the gear bags. A registration for luggage does not require the registrant to list all manners of items which the owner may carry in the luggage. Such a burden, likewise, should not be imposed on Applicant herein.

As to the identification of goods in International Class 20, applicant argues that the Examining Attorney's final requirement that its "floatable key chains" be further clarified for purposes of proper classification as "plastic floatable key chains" is too limiting since such goods could

be made of other materials and still be properly classified in International Class 20. The Examining Attorney, however, presently insists in his brief that such requirement was only a "suggestion" and that, as stated in the initial Office action, applicant need only amend the identification to "specify whether the key chains are metal or non-metal" inasmuch as "[m]etal key chains are classified in International Class 6, while non-metal key chains are classified in International Class 20."

Since applicant, in its reply brief, indicates that "[t]he description 'non-metallic floatable key chains' is ... acceptable to Applicant, and this issue may now be resolved," the identification of goods in International Class 20 is hereby deemed to be amended, pursuant to an Examiner's Amendment, to read "key chains, namely, non-metallic floatable key chains" and the refusal to register on the basis of an indefinite identification of goods is considered moot.

Turning therefore to the refusals to register on the grounds of likelihood of confusion, applicant basically argues that, as to each of the refusals, it seeks to register its "TIARA mark," which it asserts is a long-standing and famous mark for yachts⁶ ranging in price "from \$100,000 to well over

⁶ As an exhibit to its initial brief, applicant has submitted a copy of the current catalog or brochure for its yachts and the accessories therefor. While the Examining Attorney, in his brief, has not raised

\$1,000,000 when fully equipped," for a variety of collateral goods which are sold exclusively either through boat dealers or directly from applicant. Applicant maintains, in particular, that as to such goods:

The name, which is presented on the accessories of this application, is a bold display of the **TIARA®** name and is an atypical trademark usage where, for example, when purchasing a set of glassware, any trademark which may be employed would be imprinted on the bottom surface and not visible. The **TIARA®** mark, on the other hand, is dominantly displayed on the goods of the various classes of this application. Such trademark usage in connection with the channels of trade to **TIARA®** dealers or **TIARA®** Yachts itself are factors that must be considered when determining whether or not a likelihood of confusion could result amongst consumers of the goods. This non-traditional use is an integral part of the context in which the mark **TIARA®** is employed.

In view thereof, and in light of its further contention that it "has used the **TIARA** mark on the goods of this application for over 20 years without any known reports of confusion or likelihood of confusion with any of the [subject marks of] the

any objection to consideration thereof even though the evidence plainly is untimely under Trademark Rule 2.142(d), neither has he discussed or otherwise treated the brochure as if it constituted part of the record in this appeal. Moreover, while applicant has "requested that the Board, pursuant to T.B.M.P. § 712, take judicial notice of this publicly distributed catalog," we decline to do so inasmuch as such evidence is not proper subject matter for judicial notice under Fed. R. Evid. 201(b) and TBMP Section 712.01. We hasten to point out, however, that even if applicant's current catalog were to be treated as being of record, consideration thereof would make no difference in the outcome of this appeal.

registrations cited by the ... Examining Attorney, a factor which itself is strong evidence of a lack of any likelihood of confusion," applicant concludes that there is no likelihood of confusion.

We agree with the Examining Attorney, however, that when properly analyzed, confusion is indeed likely to occur. As the Examining Attorney correctly notes, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registrations. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods in the application at issue and in the cited registrations are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registrations encompass not only all goods of the nature and type described therein, but that the identified goods move in all channels of trade which would be normal for such goods and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Furthermore, it is well established that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Here, neither applicant nor the registrants have limited the channels of trade through which the respective goods travel and therefore would be found. While, concededly, boat dealers and yacht producers would not seem to be encompassed among the normal or usual channels of trade for the various goods set forth in any of the cited registrations, applicant has not restricted its goods so as to exclude the channels of trade which would be customary for the registrants' goods. Thus, applicant's "expandable gear bags

and boat duffel bags"⁷ must be treated as suitable for sale in the same retail stores, and hence to the same classes of ordinary consumers, as the "luggage" sold by one of the cited registrants. Likewise, applicant's "insulated plastic glasses, coffee mugs, [and] metal and leather coasters" must be deemed in legal contemplation to be available for sale at the same retail outlets, and thus to the identical groups of customers, as the various items of "glass gift and tableware" offered by another of the cited registrants. The same is also true with respect to applicant's "jackets, sweatshirts, parkas and baseball caps," which like the "T-shirts [and] sweaters" marketed by the third of the cited registrants, must be considered to be sold through the same department, clothing and/or specialty apparel stores and thus would be encountered by the identical classes of actual and prospective purchasers.

In addition, and while we see nothing unusual in the prominent display of a mark used in connection with collateral merchandise since one of the principal purposes of such manner of use is to advertise or promote the mark, we concur with the Examining Attorney that it is pure speculation on applicant's part that the marks of the registrants will invariably be

⁷ While applicant happens to market its "boat duffel bags" to owners of its yachts, nothing in the record indicates that such goods are suitable only for use on boats; instead, like its "expandable gear bags," applicant's "boat duffel bags" would appear to have a wide variety of general purpose uses for storage and/or carrying.

limited in their use to an inconspicuous location on the respective products. Like applicant, we note that as pointed out by the Examining Attorney, "[a] registrant is free to use its mark on its goods in any manner it wishes, and to change that use if it so desires."

In light of the above, we concur with the Examining Attorney that, as to the goods in International Class 18, there is a likelihood of confusion from contemporaneous use by applicant of the mark "TIARA" for expandable gear bags and boat duffel bags and use by one of the cited registrants of the identical mark "TIARA" in connection with luggage. To state the obvious, not only are applicant's goods arguably included within the scope of registrant's goods, but in any event expandable gear bags, boat duffel bags and luggage would all be utilized for carrying and temporarily storing a variety of items which boaters, for example, would take aboard their vessels for use on a cruise or voyage. Such closely related, if not essentially identical, goods would be regarded, when sold under the identical mark "TIARA," as emanating from the same source or sponsor.

With respect to the goods in International Class 21, we also agree with the Examining Attorney that applicant's use of the mark "TIARA" in connection with insulated plastic glasses, coffee mugs, and metal and leather coasters is likely

to cause confusion with the use by another of the registrants of the marks "TIARA" and "A TIARA EXCLUSIVE" and design for various glass gift and tableware items. Applicant's mark is obviously the same in all respects to such registrant's "TIARA" mark and is substantially similar to the registrant's "A TIARA EXCLUSIVE" and design mark. The latter, when considered in its entirety, is dominated by the word "TIARA," which constitutes not only the most prominent element of the mark visually, but is the principal source-indicative component thereof given the descriptiveness of the disclaimed term "EXCLUSIVE."⁸ Plainly, the contemporaneous use of the respective marks in connection with, in particular, such closely related drinking vessels as applicant's insulated plastic glasses and coffee mugs and the registrant's separately sold glass goblets and water tumblers, as well as its wine-set glasses, punch-set cups and beverage-set

⁸ While it is settled that the marks at issue must be considered in their entireties in determining whether there is a likelihood of confusion, it is also well established that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

tumblers, would be likely to cause confusion as to the origin or affiliation of such products.

Finally, as to the goods in International Class 25, we share the Examining Attorney's view that applicant's use of its "TIARA" mark for jackets, sweatshirts, parkas and baseball caps is likely to cause confusion with a third registrant's use of the mark "TIARA INTERNATIONAL" in connection with T-shirts and sweaters. The respective goods clearly are closely related items of outerwear which, for example, would be purchased and utilized for wearing aboard a yacht. As to the respective marks, the word "TIARA" in applicant's mark constitutes the dominant and distinguishing element of the registrant's mark, when considered in its entirety, due to the descriptiveness of the disclaimed term "INTERNATIONAL."

Applicant nevertheless argues, as previously noted, that in over 20 years of use of its "TIARA" mark, "[a]ctual confusion has never been reported to Applicant nor have any of the owners of the cited registrations ... objected to Applicant's use." Although acknowledging that "[e]vidence of 'actual confusion' is difficult to come by," applicant asserts that "many courts give significant weight to the absence of actual confusion as evidence of no likelihood of confusion."

While we agree with applicant that the absence of any instances of actual confusion over a significant period of

time is a factor indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by the registrants under their marks. See, e.g., Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). Aside from the lack in this case of a supporting affidavit or declaration from anyone associated with applicant who has personal knowledge of the extent of applicant's sales and the claimed absence of any incidents of actual confusion, the asserted fact that there has been no actual confusion would seem to be readily explained by the fact that, according to applicant, its goods have been available only through boat dealerships and from applicant itself. None of the registrants' goods, by contrast, appears to be sold or distributed in the same channels of trade as those utilized by applicant for its products. Moreover, as pointed out previously, applicant's goods--as broadly identified--must be treated as being suitable for sale in the same retail store outlets as those in which the various goods marketed by the registrants would typically be found. It is clear, however, that applicant's goods have not been sold in such trade channels and that the respective goods of applicant and each of the registrants have therefore not coexisted under the marks at issue *in the same*

marketplaces for any significant interval, much less with appreciable sales therein. Thus, applicant's assertion of a lack of any reported incidents of actual confusion is simply not a mitigating factor in this appeal. See, e.g., *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, as to applicant's contention that the purchasers of its yachts and the collateral goods offered with respect thereto are highly sophisticated and discriminating, we note that the same is not necessarily true as to the purchasers of the registrants' goods, which basically would be bought by ordinary consumers without the need to exercise much care or contemplation in their selections. In any event, we observe that, even if customers for applicant's and registrants' goods were to be regarded as sophisticated and discriminating buyers (despite the absence on this record of any evidence to support such an assumption as to the goods in issue), the fact that consumers may exercise care or thought in choosing the respective products "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

Decision: The refusals under Section 1(a)(2) are respectively reversed with respect to International Class 18 and considered to be moot as to International Class 20, but the refusals under Section 2(d) are affirmed with respect to International Classes 18, 21 and 25.

T. J. Quinn

G. D. Hohein

Judges,
Board

G. F. Rogers
Administrative Trademark
Trademark Trial and Appeal